

### REMARKS

Claims 1-32 are currently pending in the subject application and are presently under consideration. Claims 1, 3, 11, 16 and 28 have been amended as shown on pages 2-5 of the Reply. In addition, claims 2, 17, 18 and 29 have been cancelled.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 1-15 Under 35 U.S.C. §101**

Claims 1-15 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The Federal Circuit has clearly established in *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) that inventions such as that claimed by applicant is statutory.

This court must also decide whether software code made in the United States and exported abroad is a "component of a patented invention" under 271(f)... Section 271(f) refers to "components of a patented invention."... Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter."... Without question, *software code alone qualifies as an invention eligible for patenting under these categories*, at least as processes. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). (Emphasis added).

The Federal Circuit in *Eolas Techs., Inc. v. Microsoft Corp.* clearly established that software code alone is statutory subject matter. Independent claim 1 (and similarly recited in new independent claims 11) recites a ***computer implemented ... system***. A system by itself is statutory subject matter. By the standards set forth in the above decision, a computer implemented system in the form of software, hardware, or the combination of both clearly falls within the categories of statutory subject matter.

In view of at least the foregoing, it is readily apparent that applicant's invention as recited in independent claims 1 and 11 (and associated dependent claims 2-10 and 12-15) is statutory

subject matter. Accordingly, withdrawal of this rejection is respectfully requested..

**II. Rejection of Claims 1-4, 6-7, 9-12, 14-18, 20-21 and 23-32 Under 35 U.S.C. §102(e)**

Claims 1-4, 6-7, 9-12, 14-18, 20-21 and 23-32 stand rejected under 35 U.S.C. §102(e) as being anticipated by Gargi, *et al.* (US 20050027712A1). Withdrawal of this rejection is requested for at least the following reasons. The cited reference fails to teach or suggest all aspects set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it ***expressly or inherently describes each and every limitation set forth in the patent claim.*** *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The ***identical invention must be shown in as complete detail as is contained in the ... claim.*** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed invention relates to a distributed object classification systems and provides a loosely-coupled way for unrelated tools to categorize elements they control according to a common, centrally managed classification scheme. The system includes mechanisms for storing and retrieving classifying structures. In particular, amended independent claim 1 recites ***a computer readable distributed classification system having computer executable components, comprising a plurality of software components and a classification component that couples software components to a common classification structure based on a structure type and comprising structure type class, node types and structural constraints, the structural constraints define the permissible parent-child relationship between the various node types.*** Independent claims 11, 16 and 28 recite similar limitations. Gargi *et al.* fails to teach or suggest such novel features recited in the subject claims.

Gargi *et al.* teaches systems and methods for organizing a collection of objects. A given sequence of objects is segmented into object clusters. At page 3 of the Office Action, the Examiner asserts that Gargi *et al* teaches a classification component that couples software components to a common classification structure, the classification structure comprising node types and structural constraints. Applicants' representative disagrees. At the cited portions, the

cited reference teaches an object manager that arranges objects into a sequence that is ordered in accordance with context related metadata associated with the object and automatically segments them into clusters. The context related metadata is then accessed to extract names for the clusters. Further, the cited reference discloses a business process that is modeled as a direct graph having different type of nodes. Each of the nodes in the graph describes an activity performed by the process. In applicants' subject invention, the classification system includes mechanisms for storing and retrieving classifying structures, where the structures conform to a structure type and comprise nodes. The various nodes can be assembled into a list or hierarchy according to permissible parent-child relationship between them, defined by the structural constraints. However, the nodes taught by Gargi *et al.* describe an activity performed by the process and is not part of the structure, nor can be assembled into a list or hierarchy as taught by applicants' subject claims. Thus, Gargi *et al.* is silent regarding coupling software components *to a common classification structure based on a structure type and comprising structure type class, node types and structural constraints, the structural constraints define the permissible parent-child relationship between the various node types* as recited by the amended subject claims. Accordingly, it is requested that this rejection with respect to independent claims 1, 11, 16 and 28 (and the claims that depend from) should be withdrawn.

### **III. Rejection of Claims 5, 8, 13, 19 and 22 Under 35 U.S.C. §103(a)**

Claims 5, 8, 13, 19 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gargi, *et al.* in view of Omoigui, *et al.* (US 2003012636A1). It is respectfully requested that this rejection be withdrawn for at least the following reasons. Gargi *et al.* and Omoigui *et al.*, alone or in combination, do not teach or suggest all aspects set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 5, 8, 13, 19 and 22 depend from independent claims 1, 11, and 16 respectively. As discussed *supra*, concerning these independent claim, Gargi *et al.* is silent regarding *a common classification structure based on a structure type and comprising structure type class, node types and structural constraints, the structural constraints define the permissible parent-child relationship between the various node types*. Omoigui *et al.* is also silent regarding this novel limitation of the subject claims and therefore does not make up for the aforementioned deficiencies of Gargi *et al.* with respect to independent claims 1, 11 and 16. Omoigui *et al.* relates to knowledge retrieval, management and presentation of domain specific semantic information. The system provides a programmable Web, which is programmable akin to a database. Thus, applicants' invention as recited in the subject claims is not obvious over the combination of Gargi *et al.* and Omoigui *et al.* As such, it is respectfully submitted that this rejection should be withdrawn

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP636US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731